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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,393	07/10/2006	Bronwyn Annette Roberts	101016-00001	6320

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EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT	PAPER NUMBER
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1793

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12/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/549,393	Applicant(s) ROBERTS ET AL.	
	Examiner Michael A. Marcheschi	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

It is to be noted that the limitations of original claim 5 have been incorporated into claim 1, thus the following rejections take this into account and the defined rejections all where previously applied.

Claims 1-4, 6-7 and 14-19 are rejected under 35 U.S.C. 103(a) as obvious over Portwood et al. (008) in view of Hall (918) for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as obvious over Portwood et al. (008) in view of Hall (918) alone, as applied to claim 1 above or further in view of Dossena et al. (358) for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as obvious over Portwood et al. (008) in view of Hall (918) as applied to claim 1 above, and further in view of EP 411831 for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claim 12 is rejected under 35 U.S.C. 103(a) as obvious over Portwood et al. (008) in view of Hall (918) and further in view of EP 411831, as applied to claim 11 above, and further in view of Tank et al. (268) for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claim 13 is rejected under 35 U.S.C. 103(a) as obvious over Portwood et al. (008) in view of Hall (918) and further in view of EP 411831, as applied to claim 11 above, and further in view of Tank et al. (748) for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 1-4, 6-7, 9, 11, 14-15 and 17-18 are rejected under 35 U.S.C. 103(a) as obvious over EP 411,831 in view of Hall (918) for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 8, 10, 16 and 19 are rejected under 35 U.S.C. 103(a) as obvious over EP 411831 in view of Hall (918), as applied to claims 1 and 14 above in view of Portwood et al. (008) alone or further in view of Dossena et al. (358) for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claim 12 is rejected under 35 U.S.C. 103(a) as obvious over EP 411831 in view of Hall (918), as applied to claim 11 above in view of Tank et al. (268) for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claim 13 is rejected under 35 U.S.C. 103(a) as obvious over EP 411831 in view of Hall (918) as applied to claim 11 above, and further in view of Tank et al. (748) for the same reasons set forth in the previous office action which are incorporated herein by reference.

Applicant's arguments filed 11/4/08 have been fully considered but they are not persuasive.

Applicants argue that Portwood or Reed can not be combined with Hall because Portwood and Reed teaches a tool wherein the outer region is less wear resistant than the inner region and Hall teaches the opposite construction (the outer region is greater in wear resistance than the inner region). This is not fully persuasive because where in the reference is this stated. Even assuming further *arguendo* (which the examiner disagrees with applicants position above), the examiner has only applied Hall to show that the thickness of the outer region is known, irrespective of it being the one with greater wear resistance or less in wear resistance. Applicants do not argue the specific reasoning behind the rejection (why one could not or would not under any circumstance use the thickness of the outer region disclosed by Hall as the thickness for the outer region of Portwood or Reed). Only for the benefit of responding to applicants positions taken, even assuming further *arguendo* about this, it is to be noted that column 17, lines 10-11 appear to be defining that the layer with less wear resistance is 380 microns (clearly within applicants range).

Applicants further argue that even if such a combination was made, the resulting structure would be different from the claimed structure because the resulting structure would be a cutting element which has a region of greater wear resistance that is about 125 microns. The examiner disagrees because, as previously defined, the obvious aspect of the rejection stated that "it is known that the outermost region of the working layer is usually defined with a thickness of 125 microns (column 17, lines 8-10 of the Hall) and thus the skilled artisan would have been motivated to provide the outer layer with any conventional thickness known in the art and applicants have not shown any

clear evidence rebutting the examiners specific reasons for combining (i.e. why one could not or would not under any circumstance use the thickness of the outer region disclosed by Hall as the thickness for the outer region of Portwood or Reed).

Finally, the examiner also made an obviousness determination that “the desired thickness would have been an obvious design choice depending on the application of tool component sought” and applicants have failed to argue this point..

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1793

examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael A Marcheschi/
Primary Examiner, Art Unit 1793